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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/770,462	01/29/2001	John A. Kriho	014530/0320	8030

22428 7590 05/05/2005

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EXAMINER

HUYNH, CONG LAC T

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/770,462

Applicant(s)

KRIHO ET AL.

Examiner

Cong-Lac Huynh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 40-77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 40-77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: RCE filed 4/11/05 to the application filed on 1/29/01.
2. Claims 40-77 are pending in the case. Claims 40, 50, 58, 59, 68 and 77 are independent claims.
3. The affidavit under 37 CFR 1.132 filed 4/11/05 is insufficient to overcome the rejection of claims 40-77 based upon Kraft and Dunsmoir as set forth in the last Office action because: the affidavit attempts to show that a page layout application is for placing and arranging and rearranging text and graphics on the page to produce documents such as newsletters, brochures, books, etc. by providing an article on the Internet regarding the page layout software. However, a page layout is merely a template of any type of documents to an ordinary skill in the art. And thus, a page layout application is an application that allows a user to create a page by entering data into predefined fields of a template which arranges the data objects in a page, or allows a user to modify a template to create a page. The claimed limitations (claims 50 and 58, for example) recite "receive a changeable field designated by a user within a template wherein the changeable field comprises a name and a plurality of data items linked to the changeable field, and further wherein the template is designed using a page layout application." Kraft shows modifying a row in a template (col 5, line 63 to col 6, line 19, figure 2) where it is clear that said row is a changeable field in a template. Dunsmoir discloses "providing a server-side modifying web page template including

format definitions, at least one of which format definitions is a web page inclusion command" (col 5, lines 63-65) showing that a web page template is modified at server. The used references, therefore, read on the claimed limitations.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 40-46, 49-54, 57-58 remain rejected under 35 U.S.C. 102(a) as being anticipated by Kraft et al. (US pat No. 6,084,585, 7/4/00, filed 7/29/98, priority 12/5/97).

Regarding independent claim 40, Kraft discloses:

- designating a template using a page layout application (col 9, line 1 to col 10, line 13: selecting a row template to expand or delete a data field in the template shows designating a template using a page layout application)
- designating a changeable field within a template wherein the changeable field includes a name (col 5, line 63 to col 6, line 19, figure 2: the field within the template is changeable since it can be expand to add more entry by users and each field has a name)

- linking a plurality of data items to the changeable field (col 5, lines 37-43: data linked to the fields are pre-programmed for users to select; col 8, lines 43-58 and figure 6: a plurality of data linked to the field for user to select)
- creating a form wherein the form comprises the name of the changeable field paired with a list of the plurality of data items linked to the changeable field (figure 6 and col 8, lines 43-58: field name 312 paired with a list of data items in the pull-down menu 602 linked to said field)
- selecting a data item from the list (col 8, lines 43-58)
- populating the changeable field of the template with the selected data item thereby generating a document (figure 2 and col 8, lines 43-58: selecting a data item to populate the changeable field of the template to generate the complete form)

Regarding claim 41, which is dependent on claim 40, Kraft discloses providing a preview of the document by populating the changeable field of the template with one of the plurality of data items linked to the changeable field (col 2, lines 22-39, col 10, lines 34-44: view the form prior submission).

Regarding claim 42, which is dependent on claim 41, Kraft discloses populating the changeable field of the template with one of the plurality of data items comprises defining a default selection to populate the changeable field (col 8, lines 43-58: the list

of pre-entered data entries is the plurality of data items defined as a default selection of data to populate the changeable field).

Regarding claim 43, which is dependent on claim 41, Kraft discloses that populating the changeable field of the template with one of the plurality of data items comprises iteratively showing the preview with each data item in the list (col 2, lines 30-34).

Regarding claim 44, which is dependent on claim 40, Kraft discloses bundling the plurality of data items with the template in a file (col 5, lines 37-43, col 8, lines 43-58).

Regarding claim 45, which is dependent on claim 44, Kraft discloses that the file has a format of a layout application used to design the template (col 7, lines 50-67).

Regarding claim 46, which is dependent on claim 44, Kraft discloses sending the file to a server, extracting the template and the plurality of data items from the file at the server, and saving the extracted template and the extracted plurality of data items in a database (figure 1, col 10, lines 1-22: sending the complete form to the server; col 10, lines 15-25, 45-55, col 3, lines 5-31, figure 1: the data items and the template in the complete form when submitted to the server will be stored in the storage 108-110, which is a server database).

Regarding claim 49, which is dependent on claim 40, Kraft discloses automatically adjusting a size of the selected data item based on a size of the changeable field (col 9, lines 7-18: changing the size of a field by adding extra data fields to be associated with

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a single menu field, the existing data field can be enlarged shows that the size of the 46field is adjusted).

Claims 50-54, 57 are for a computer program product of method claims 40-46, 49, respectively, and are rejected under the same rationale.

Claim 58 is for a system of method claim 40, and is rejected under the same rationale.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 47 and 55 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Kraft as applied to claim 40 above, and further in view of Dunsmoir et al. (US Pat No. 6,507,854 B1, 1/14/03, filed 11/5/99).

Regarding claim 47, which is dependent on claim 46, Kraft does not disclose modifying the template using a layout application used to design the template, the layout application executing at the server.

Dunsmoir discloses modifying the template using a layout application used to design the template, the layout application executing at the server (col 5, lines 58-67: "providing a server-side modifying web page template including format definitions, at least one of which format definitions is a web page inclusion command").

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Dunsmoir into Kraft since Dunsmoir discloses modifying the template at the server providing the advantage to incorporate into Kraft for modifying the form in Kraft, which is a template, when said form is submitted to the server.

Claim 55 is for a computer program product of method claim 47, and is rejected under the same rationale.

9. Claims 48 and 56 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Kraft as applied to claim 40 above, and further in view of Billiris et al. (US Pat No. 6,212,552 B1, 4/3/01, filed 1/15/98).

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Regarding claim 48, which is dependent on claim 40, Kraft does not disclose creating a mailing list, wherein the mailing list comprises a plurality of records to link to the changeable field of the template, and successfully populating the changeable field of the template with a record from the mailing list thereby generating a different document for each record.

Billiris discloses creating a mailing list, wherein the mailing list comprises a plurality of identities of message recipients (col 1, lines 40-64).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Billiris and combined Billiris into Kraft for linking the mailing list to the changeable field of the template and populating the changeable field of the template with a record from the mailing list to generate a different document for each record for the following reason. The mailing list including identities of message recipients in Billiris is a list of records of recipients as the plurality of data in Kraft.

Replacing the plurality of data linking to the changeable field in Kraft with the plurality of records of recipients in the mailing list linking to the changeable field and populating such records to the changeable field would provide different types of data to be used in populating the fields in the form.

Claim 56 is for a computer program product of method claim 48, and is rejected under the same rationale.

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10. Claims 59-63, 65-72, 74-77 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Kraft et al. (US Pat No. 6,084,585, 7/4/00, filed 7/29/98, priority 12/5/97) in view of Dunsmoir et al. (US Pat No. 6,507,854 B1, 1/14/03, filed 11/5/99).

Regarding independent claim 59, Kraft discloses:

- designating a changeable field within a template wherein the changeable field includes a name (col 5, line 63 to col 6, line 19, figure 2: the field within the template is changeable since it can be expand to add more entry by users and each field has a name)
- linking a plurality of data items to the changeable field (col 5, lines 37-43: data linked to the fields are pre-programmed for users to select; col 8, lines 43-58 and figure 6: a plurality of data linked to the field for user to select)
- sending the template and the plurality of data items to a server (col 10, lines 15-22 and figure 1: the complete form including the template and the plurality of data items is sent to computer 102, which is a server)

Kraft does not disclose:

- editing the template using the layout application, the layout application executing at the server

Dunsmoir discloses:

- editing the template using the layout application, the layout application executing at the server (col 5, lines 58-67)

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It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Dunsmoir into Kraft since Dunsmoir discloses modifying the template at the server providing the advantage to incorporate into Kraft for modifying the form in Kraft, which is a template, when said form is submitted to the server.

Regarding claim 60, which is dependent on claim 59, Kraft discloses:

- creating a form wherein the form comprises the name of the changeable field paired with a list of the plurality of data items linked to the changeable field (figure 6 and col 8, lines 43-58: field name 312 paired with a list of data items in the pull-down menu 602 linked to said field)
- selecting a data item from the list (col 8, lines 43-58)
- populating the changeable field of the template with the selected data item thereby generating a document (figure 2 and col 8, lines 43-58: selecting a data item to populate the changeable field of the template to generate the complete form)

Regarding claim 61, which is dependent on claim 60, Kraft discloses providing a preview of the document by populating the changeable field of the template with one of the plurality of data items linked to the changeable field (col 2, lines 22-39, col 10, lines 34-44: view the form prior submission).

Regarding claim 62, which is dependent on claim 61, Kraft discloses populating the changeable field of the template with one of the plurality of data items comprises

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defining a default selection to populate the changeable field (col 8, lines 43-58: the list of pre-entered data entries is the plurality of data items defined as a default selection of data to populate the changeable field).

Regarding claim 63, which is dependent on claim 61, Kraft discloses that populating the changeable field of the template with one of the plurality of data items comprises iteratively showing the preview with each data item in the list (col 2, lines 30-34).

Regarding claim 65, which is dependent on claim 60, Kraft discloses automatically adjusting a size of the selected data item based on a size of the changeable field (col 9, lines 7-18: changing the size of a field by adding extra data fields to be associated with a single menu field, the existing data field can be enlarged shows that the size of the field is adjusted).

Regarding claim 66, which is dependent on claim 60, Kraft discloses bundling the plurality of data items with the template in a file (col 5, lines 37-43, col 8, lines 43-58).

Regarding claim 67, which is dependent on claim 66, Kraft discloses sending the file to a server, extracting the template and the plurality of data items from the file at the server, and saving the extracted template and the extracted plurality of data items in a database (figure 1, col 10, lines 1-22: sending the complete form to the server; col 10, lines 15-25, 45-55, col 3, lines 5-31, figure 1: the data items and the template in the

complete form when submitted to the server will be stored in the storage 108-110, which is a server database).

Claims 68-72, 74-76 are for a computer program product of method claims 59-63, 65-67, respectively, and are rejected under the same rationale.

Claim 77 is for a system of method claim 59, and is rejected under the same rationale.

11. Claims 64 and 73 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Kraft and Dunsmoir as applied in claim 60 above and further in view of Billiris et al (US Pat No. 6,212,552 B1, 4/3/01, filed 1/15/98).

Regarding claim 64, which is dependent on claim 60, Kraft and Dunsmoir do not disclose creating a mailing list, wherein the mailing list comprises a plurality of records to link to the changeable field of the template, and successfully populating the changeable field of the template with a record from the mailing list thereby generating a different document for each record.

Billiris discloses creating a mailing list, wherein the mailing list comprises a plurality of identities of message recipients (col 1, lines 40-64).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Billiris and combined Billiris into Kraft and Dunsmoir for linking the mailing list to the changeable field of the template and populating the

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changeable field of the template with a record from the mailing list to generate a different document for each record for the following reason. The mailing list including identities of message recipients in Billiris is a list of records of recipients as the plurality of data in Kraft. Replacing the plurality of data linking to the changeable field in Kraft with the plurality of records of recipients in the mailing list linking to the changeable field and populating such records to the changeable field would provide different types of data to be used in populating the fields in the form.

Claim 73 is for a computer program product of method claim 64, and is rejected under the same rationale.

Response to Arguments

12. Applicant's arguments filed 4/11/05 have been fully considered but they are not persuasive.

Applicants argue that Kraft does not disclose the intended program that receive the data from the form at all, and as a result, Kraft fails to describe, suggest, or teach use of a "page layout application" (Remarks, page 12).

Examiner respectfully disagrees.

A page layout application is merely a page template application that allows a user to create a page by entering data into predefined fields of a template which arranges the data objects in a page.

Kraft discloses entering data into the data fields of a template (col 5, lines 15-43, 63 to col 6, line 19, col 8, lines 1-42) which shows receiving the data from the form via

receiving the entered data to the template to create a page. Kraft, thus, teaches use of a “page layout application” as argued.

Applicants argue that Dunsmoir fails to describe, suggest, or teach use of a “page layout application” since the HTML output as disclosed in Dunsmoir is not designed using a page layout application (Remarks, page 12).

Examiner respectfully disagrees.

Dunsmoir discloses “providing a server-side modifying web page template including format definitions, at least one of which format definitions is a web page inclusion command” (col 5, lines 63-65). As mentioned above, a page layout application is merely an application of page templates that allows a user to create a page by entering data into predefined fields of a template which arranges the data objects in a page. Dunsmoir discloses a modifying web page template. Therefore, Dunsmoir discloses use of a “page layout application” as argued.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Mohr et al. (US Pat No. 6,826,727 B1, 11/30/04, filed 11/24/99).

Alexander (US Pat No. 6,697,754 B1, 2/24/04, filed 8/9/00).

Underwood et al. (US Pat No. 6,601,057 B1, 7/29/03, filed 10/30/00).

Scheifler et al. (US Pat No. 6,578,044 B1, 6/10/03, filed 3/20/98).

Breslau et al. (US Pat No. 6,499,041 B1, 12/24/02, filed 12/29/98).

Ishikawa (US Pat No. 6,466,239 B2, 10/15/02, filed 9/24/98).

Bourke-Dunphy et al. (US Pat No. 6,449,642 B2, 9/10/02, filed 9/15/98).

Lao et al. (US Pat App Pub No. 2002/0116293 A1, 8/22/02, filed 2/21/01, priority 11/3/00).

Lavorgna, JR. et al. (US Pat App Pub No. 2002/0184043 A1, 12/5/02, filed 6/4/01).

Fai et al. (US Pat App Pub No. 2003/0046639 A1, 3/6/03, filed 5/9/02, priority 5/9/01).

Resnick et al. (US Pat App Pub No. 2003/0009250 A1, 1/9/03, filed 6/24/02, priority 6/22/01).

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-4125. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-4125.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cong-Lac Huynh
Examiner
Art Unit 2178
04/29/05